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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,506	11/14/2003	Marvin C. Buchanan SR.	130601.2	9964

24219 7590 12/01/2004

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EXAMINER

BRINSON, PATRICK F

ART UNIT PAPER NUMBER

3754

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/713,506	Applicant(s) BUCHANAN, MARVIN C.	
	Examiner Patrick F. Brinson	Art Unit 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
4a) Of the above claim(s) 1-10 and 28 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23 is/are allowed.
- 6) ☒ Claim(s) 11-14, 20-22 and 24 is/are rejected.
- 7) ☒ Claim(s) 15-19 and 25-27 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/14/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 11-27 in the reply filed on 20 September 2004 is acknowledged.

Claim Objections

2. Claims 15 and 25 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 16 and 26, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-14, 20 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,605,043 to **Grenier**.

The patent to **Grenier** discloses an insulation material for fluid conduits including a jacket (10) having an inner side and an outer side and a first edge.

Insulation material (13) attached to an inner side of the jacket with the jacket extending beyond the insulation and configured to form a flange (15), as shown in fig. 4, having a free end generally opposite the first edge of the jacket. The flange defining an inner side and an outer side substantially opposite the inner side. The first edge of the jacket (15) and second edge (16) configured to be generally adjacent to one another upon the jacket being wrapped around the fluid conduit. An elongated strip of material (18) integral with and extending substantially the length of the flange and defining a strip free end separate from the free end of the flange, wherein the free end of the flange is configured to be independently movable with respect to the strip free end. The strip of material having an adhesive portion (20) and a removable release member (21), which is configured to allow the adhesive portion to be selectively exposed and the adhesive portion is configured, upon removal of the release member and first end of the jacket being adjacent to one another, to adhere to the outer side of the flange, as recited in claims 11, 14 and 24. The strip of material extends beyond the free end of the flange by a predetermined distance, as recited in claims 12 and 13. **Grenier** also discloses tab members, fig. 2, (27) extending from the first edge end including a tab adhesive portion, like that of the main body strip (18) which is configured, upon removal of a release strip, to adhere to the fluid conduit, as recited in claim 20.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Grenier**.

Figs. 3 and 4 of the patent to **Grenier** discloses the structure with approximately one third of the flange adhesive portion attaching the flap to flange and approximately two thirds of the width of the flap extending beyond the free end of the flange. **Grenier** does not disclose only approximately one third of the flap extending beyond the flap free end of the flange. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to form the flap to extend one third instead of two thirds beyond the free end of the flange because Applicant has not disclosed that this particular structure provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the flap extending two thirds beyond the

flange. Therefore, it would have been an obvious matter of design choice to modify **Grenier** to obtain the invention as specified in claims 21 and 22.

Allowable Subject Matter

5. Claims 15-19 and 25-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claim 23 is allowed.


Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Cohen et al., '908 and '701, Knittel et al. '574 and '088, McClintock, Cohen, Lauer '593 and '371, Simmons et al., Vitoorapakorn, Hepner et al., Robbins are pertinent to Applicant's invention in disclosing pipe insulation with adhesive portions to connect the edge portions over the conduit. The patent to Whitty is pertinent to Applicant's invention in disclosing pipe insulation including fasteners.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Patrick F. Brinson** whose telephone number is (571) 272-4897. The examiner can normally be reached on M-F 7:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Michael Y. Mar** can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick F. Brinson
Primary Examiner
Art Unit 3754

P. F. Brinson
November 29, 2004